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09/607,553	06/29/2000	Greg Lane	11712/1	8510

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EXAMINER
EDELMAN, BRADLEY E

ART UNIT	PAPER NUMBER
2153	6

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/607,553	Applicant(s) LANE, GREG	
	Examiner Bradley Edelman	Art Unit 2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,9,13-16,20-24 and 26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,9,13-16,20-24 and 26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *29 June 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

This Office action is in response to Applicant's amendment filed on October 22, 2003. Claims 1, 9, 13-16, 20-24, and 26 are presented for further examination. Although the subject matter of these claims had been indicated as allowable in the previous Office action, these claims are now rejected after further consideration and discovery of additional prior art. Because of the new grounds for rejection, this action is non-final.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 20-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Arnold et al. (U.S. Patent No. 6,016,504, hereinafter "Arnold").

In considering claim 20, note that the claim is broadly worded such that a typical Web browser banner ad that, when clicked on, causes the browser to open a page to an associated company's interactive Web site, reads on the claim. An explanation follows.

The preamble of the claim describes a method for enabling a user to obtain a program object for use in a host application running on a client computer, the client

computer coupled to a server via a network. In the typical banner ad situation, the "program object" would be the clickable banner ad, and the "host application" would be the browser on the user's client computer.

Step (a) of the claim describes enabling the host application to display a limited functionality object at the client computer. In the banner ad situation, the browser displays a banner ad – which has limited functionality because it can only be clicked on – at the client computer.

Step (b) describes enabling the user the ability to select the limited functionality object. In the banner ad situation, a user clicks on the banner ad.

Step (c) describes upon such selection, sending to the server computer a request for a full functionality object corresponding to the limited functionality object. In the banner ad situation, the user's clicking on the ad requests the ad server to send its fully functional home page corresponding to the ad to the client computer.

Step (d) describes receiving the full functionality object at the client computer from the server computer. In the banner ad situation, the client computer receives the advertising company's home page.

Step (e) describes integrating the full functionality object in the host application without halting or restarting the host application. In the banner ad situation, the home page is displayed in the client browser without restarting or halting the browser program.

Finally, step (f) describes allowing the user to manipulate the full functionality object. In the banner ad situation, the user can click on links and enter information into input fields on the advertiser's homepage.

Arnold discloses this typical banner ad situation on col. 2, lines 55-67 ("The banner ad has a hot link to the selling site. A Web surfer (i.e. potential customer) will notice the ad, then 'click' on it and thereby pass through to the selling site, where a purchase may be made."

Note: even a simple html hyperlink linking to an online retailer's site can read on this claim, as broadly worded. The hyperlink comprises the "limited functionality object" and the company's interactive website comprises the "full functionality object."

In considering claim 21, the typical banner ad situation, as exemplified by Arnold, further teaches that the full functional object is a unique full functional object (i.e. there is only one unique homepage linked to the banner ad).

In considering claim 22, the typical banner ad situation, as exemplified by Arnold, further teaches enabling the user to provide identifying data and payment data to the server computer (i.e. making a purchase online requires providing identifying data and payment data).

In considering claim 23, the typical banner ad situation, as exemplified by Arnold, further teaches transmitting the full functionality object to a second client computer (i.e. any computers on the Internet that click on the banner ad will receive the homepage).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leovac (U.S. Patent No. 6,668,375), in view of Halpern et al. (U.S. Patent No. 6,282,711, hereinafter "Halpern").

In considering claim 1, Leovac discloses a computer-implemented method for enabling a user ("customer," col. 2, line 37) to obtain a program object ("software application," col. 2, line 38) for use in a host application ("Microsoft Windows operating system," col. 2, line 46) running on a client computer ("customer system," col. 2, line 40), the client computer coupled to a server computer ("customer service system," col. 2, lines 40-41) via a network ("Internet," Fig. 2), the method comprising the steps of:

(e) allowing the host application ("Microsoft Windows operating system") to utilize a limited functionality object (col. 2, lines 37-39, "customer system 10 has installed on it a software application 25a consisting of a basic build 26, and possibly some options");

(f) upon user request at the client computer, sending a request to a server computer to obtain a full functionality object corresponding to the limited functionality object (col. 2, lines 39-42, "the customer... can use the customer system 10 to request that a customer service system... enables installing additional or different options");

(g) at the client computer, determining a set of program parts required to create the full functionality object from the limited functionality object (col. 2, lines 39-42; col. 4, lines 5-9, "requestor 43 makes available to the user a list of the available software options 45 from which the customer can make a selection");

(h) downloading the set of program parts from the server computer to the client computer (col. 3, lines 37-38; col. 4, lines 29-34, "customer service then prepares and sends to the customer a key to unlock the requested options," wherein the key "correspond[s] to the request for new options");

(i) at the client computer, combining the set of program parts and the limited functionality object to create the full functionality object (col. 4, lines 12-22, wherein the key is used to install the new options to the customer system); and

(j) allowing the host application to utilize the full functionality object (i.e. once the new options are installed, the operating system can use the newly updated, full functionality software application).

However, Leovac remains silent as to how the limited functionality object (i.e. the basic software application) was initially installed on the customer system. Therefore, Leovac does not disclose steps (a) – (d) of the claimed invention. Steps (a) – (d) describe a method for downloading a limited functionality object, including (a) allowing a user to select a program object, (b) and (c) customizing the program at a server computer according to user input, and according to a rule-set in a program object template corresponding to the object, to create a limited functionality object, and (d) downloading the limited functionality object from the server to the client. Nonetheless,

there are many well-known methods for downloading and installing software onto a networked client computer system. The method disclosed in steps (a) – (d) is one such well-known method, as evidenced by Halpern.

In a similar art, Halpern discloses a system for downloading and installing software applications on a client computer via a network (Abstract), including:

(a) allowing a user to select a program object (col. 5, lines 43-44, "the user then selects the components and options that interest him/her"),

(b) and (c) customizing the program at a server computer according to user input, and according to a rule-set ("installer generator") in a program object template ("component pool") corresponding to the object, to create a limited functionality object (col. 5, lines 49-55, "in response to the user's selections, the options manager 104 delivers an installation and/or options specification to an installer set generator 109. The installer set generator 109 accesses the component pool 107 and dynamically produces a customized, non-binding set of files required from the selected components and options..."), and

(d) downloading the limited functionality object from the server to the client (col. 6, lines 17-19, "the executable prepared by the packager 110 is then transmitted over the web to the client system 101").

Given this teaching, a person having ordinary skill in the art would have readily recognized the desirability and advantages of using the installation method taught by Halpern to install the limited functionality object in the system taught by Leovac, to "permit a user to obtain the software he wants without having to download extraneous

program files." See Halpern, col. 4, lines 20-21. Therefore, it would have been obvious to install the limited functionality object taught by Leovac using the installation method taught by Halpern.

3. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Patterson (U.S. Patent No. 6,389,541), in view of Nehab et al. (U.S. Patent No. 6,029,182, hereinafter "Nehab").

In considering claim 9, Patterson discloses a computer-implemented method for enabling a user ("user," col. 8, line 37) to obtain a program object ("object," col. 8, line 22) for use in a host application ("browser," col. 7, line 61; or "Microsoft Windows Operating System," col. 8, line 64) running on a client computer ("client computer," col. 8, line 46), the client computer coupled to a server computer ("server," col. 8, line 44; "payment server," col. 9, line 52) via a network ("Internet," col. 7, line 61), the method comprising the steps of:

(a) enabling the user to select a program object (col. 8, line 37, "the user can select the object desired");

(c) downloading the object from the server computer to the client computer (col. 8, lines 37-39, "can have [the object] delivered electronically, such as by email or using File Transfer Protocol");

(d) integrating the object in the host application (col. 9, lines 26-28, "the solicitation form 100 is stored as part of the object, and allows the user to enter payment information or 'use information' for the object");

(e) storing the identity of the user in a sales database, the identity of the user being associated with the object in the sales database (col. 10, lines 28-30, "the payment server stores the payment/use information that had been submitted, along with the authorization code," wherein the "database" is inherently used for storing user payment information and authorization information);

(f) accessing the sales database to determine the identity of the user associated with the object (col. 9, line 57 – col. 10, line 22, wherein upon user request, the server accesses the credit card and authorization information associated with the user, and wherein the "database" is inherently used for storing user payment information and authorization information);

(g) enabling the user to electronically transfer the object to a second user at a second client computer (col. 11, lines 4-7, "the object thereafter may be copied or transmitted to other client computers"); and

(h) amending the sales database to store the identity of the second user as being associated with the object (col. 11, lines 5-7, wherein the second client computer will repeat the same process as the first one for authentication and sales information, and therefore will store the identity of the second user in the sales database as being associated with the object).

However, Patterson does not disclose that the program object is customized at the server computer according to a rule-set to create a unique object. Patterson discloses that the program object can be a digital newspaper consisting of HTML files (col. 11, lines 47-48). However, Patterson does not disclose that the digital newspaper

is customized according to a rule-set. Nonetheless, customizing HTML newspapers for online users is well known in the art, as evidenced by Nehab. In a similar art, Nehab discloses a network system for downloading information from servers to clients, wherein "the invention retrieves articles from a hypermedia-linked computer network and formats the articles into a personalized newspaper" (col. 3, lines 15-17), and wherein the newspaper is customized according to a rule-set ("based on command data stored in the personal-news-profile," col. 3, lines 21-24). Given the teaching of Nehab, a person having ordinary skill in the art would have readily recognized the desirability and advantages of customizing the newspaper downloaded in the system taught by Patterson, so that the user can retrieve only the information that he/she considers important, thereby saving network bandwidth and improving user control over the system. Therefore, it would have been obvious to customize the newspaper downloaded in the system taught by Patterson.

4. Claims 13-16, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leovac, in view of Halpern, and further in view of Ronning (U.S. Patent No. 5,907,617).

In considering claim 13, claim 13 presents most of the same features as claim 1. For instance, steps (a) – (c) of claim 13 present no further limitations over steps (c) – (e) of claim 1; steps (e), (f), and (g) of claim 13 present no further limitations over steps (f), (h), and (i) of claim 1. Thus, only steps (d) and (h) differ between claim 1 and claim 13. In considering these steps, claim 13 presents the additional limitation that the user

cannot control the limited functionality object, but the user can control the full functionality object. The combined system of Leovac and Halpern does not disclose this feature, because the combined system of Leovac and Halpern does not describe the specific features contained in each of the limited and fully functional objects. Instead, the systems of Leovac and Halpern demonstrate the general ability to upgrade software from one version to a new version with added capabilities.

Nonetheless, one well-known feature of software upgrading systems is the ability to distribute one version of the software with portions that cannot be controlled by a user (i.e. "trial software" or "demo versions"), and then to upgrade from that version to a fully functional version that allows user control over all features of the software. Such an upgrading system is disclosed by Ronning (see Abstract; col. 1, lines 23-34). Given this knowledge, a person having ordinary skill in the art would have readily recognized the desirability and advantages of employing the software upgrading system taught by Leovac and Halpern for upgrading from trial version software to fully operational software, so that companies could easily market their software products over the Internet. Therefore, it would have been obvious for the users to have no control over the limited functionality object features, and to have control over the fully functional object features in the system taught by Leovac and Halpern.

In considering claim 14, Leovac further discloses that the full functionality object is integrated into the host application without halting or restarting the host application

(col. 3, lines 35-65, wherein the new options are "unlocked" and installed onto the operating system without having to restart the operating system).

In considering claim 15, Halpern further discloses that the limited functionality object is integrated into the host application without halting or restarting the host application (col. 6, lines 15-20, wherein the limited functionality object is a "self-extracting executable" and therefore does not require a restart or halting of the operating system).

In considering claim 16, Halpern further discloses that the customized program is a unique limited functionality object (col. 5, lines 49-55, wherein the program is customized uniquely according to the user's preferences).

In considering claim 24, claim 24 presents an e-commerce system for performing the same steps disclosed in claim 13. Therefore, claim 24 is rejected for the same reasons as claim 13.

5. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander et al. (U.S. Patent No. 6,134,593, hereinafter "Alexander"), in view of Halpern.

In considering claim 26, Alexander discloses a network comprising a client computer ("client 110," col. 2, line 59) running a host application ("Microsoft Windows operating system," col. 4, lines 51-52) and coupled to a server computer ("server 150," col. 2, line 60) for distributing program objects via a network, comprising:

One or more program objects stored at the server computer, the program objects consisting of limited functionality program objects ("demonstration module providing limited functionality," col. 3, lines 55-56) and full functionality program objects ("commercial module providing full functionality," col. 3, lines 57-58), and transmitting said program objects to the client computer (col. 5, lines 55-59, wherein "both a demonstration software module and a fully functioning commercial software module" have been transmitted to the client);

A sales database at the server ("database on the server 150 maintains information regarding at least one vendor," col. 6, lines 65-66) for storing details regarding each person who obtains a full functional program object (col. 7, lines 1-24, wherein information about installed software, user passwords, and payment information is stored at the server);

A client computer program ("World Wide Web" browser, col. 6, lines 50-53) running on the client computer in conjunction with the host application the client computer program enabling the host application to request program objects from the server computer program and integrate program objects (col. 6, lines 38-53, wherein the user enters installation information and sends it over the Web to obtain program objects for the full functional program);

Wherein the limited functionality object, when executed by the host application, is displayed but cannot be controlled by a user (col. 3, lines 60-63, wherein the commercial module "is accessible only after payment is received" and thus constitutes a limited functionality object that cannot be controlled by a user); and

Wherein a full functionality object, when executed by the host application, is displayed and can be controlled by the user (col. 4, lines 60-65, wherein "if the [full functionality module] is unlocked, it can be immediately executed").

However, Alexander remains silent as to how the limited functionality object (i.e. the basic software application) is created at the server. Therefore, Alexander does not disclose the steps of maintaining an object template at the server, each template providing a definition for a program object and a rule-set to create the program object, wherein the program objects are created from the template. Nonetheless, there are many well-known methods for creating software objects to be distributed to end users. The method of using a template in the manner claimed is one such well-known method, as evidenced by Halpern.

In a similar art, Halpern discloses a system for downloading and installing software applications onto a client computer via a network (Abstract), that includes the use of a rule-set ("installer generator") in a program object template ("component pool") corresponding to the object, to create the program object (col. 5, lines 49-55, "in response to the user's selections, the options manager 104 delivers an installation and/or options specification to an installer set generator 109. The installer set generator 109 accesses the component pool 107 and dynamically produces a customized, non-

binding set of files required from the selected components and options..."). Given this teaching, a person having ordinary skill in the art would have readily recognized the desirability and advantages of using the program creation and installation method taught by Halpern to install the program objects in the system taught by Alexander, to "permit a user to obtain the software he wants without having to download extraneous program files." See Halpern, col. 4, lines 20-21. Therefore, it would have been obvious to create and install the program objects taught by Alexander using the method taught by Halpern.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is (703) 306-3041. The examiner can normally be reached on Monday to Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on (703) 305-4792. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

For all correspondences: (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Bradley Edelman

BE
February 19, 2004